



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*JD*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/128,340 08/03/98 LLORIN

0 P-4278

EXAMINER

HM22/0825

RICHARD RODRICK  
BECTON DICKINSON & COMPANY  
1 BECTON DRIVE  
MAIL CODE 089  
FRANKLIN LAKES NJ 07417-1880

WARE, D

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

08/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Notification of Non-Compliance with  
37 CFR 1.192(c)**

Application No.  
**09/128,340**

Applicant(s)

**Llorin**

Examiner

**Ware**

Group Art Unit  
**1651**



The Appeal Brief filed on Jun 29, 2000 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

Applicant is given a TIME LIMIT of ONE MONTH from the date of this letter or any time remaining in the period under 37 CFR 1.192(a) for filing a new complete brief. If a new brief that fully complies with 37 CFR 1.192(c) is not timely submitted, the appeal will be dismissed. The new complete brief must be filed IN TRIPLICATE. See 37 CFR 1.192(a).

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☒ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
  - a. ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - b. ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

*The requisite fee which must accompany the brief has been omitted. See 37 CFR 1.17(f). Furthermore, the brief was not filed in triplicate.*

DAVID M. NAIFF  
PRIMARY EXAMINER  
ART UNIT 1651

Art Unit: 1651

### ATTACHMENT A

Claims 1 and 3-13 are presented for reconsideration on the merits after final.

The after final filed March 6, 2000, has been received and will be entered.

The rejection of claims 5-13 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at that time, had possession of the claimed invention as set forth in the final action of January 4, 2000, has been removed in response to the after final amendment filed March 6, 2000. However, the claims 5-13 remain rejected under 35 U.S.C. 112, second paragraph, for those reasons of record.

Furthermore, the rejection of claims 1 and 3-13 under 35 U.S.C. 103 is maintained and applicants' arguments set forth in the after final amendment of March 6, 2000, were not deemed persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., combination of sonication of an alkaline solution for cell disruption) are not recited in the rejected claims 8-10. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, the use of alkaline

Art Unit: 1651

solution for disrupting cells and sonication for the disruption of cells are both well recognized techniques in the art as described on the record in previous Office actions. Thus, one of skill would have been motivated to use such techniques in combination, especially since the same techniques are discussed within the same reference. To use them together to enhance cell disruption is clearly within the purview of an ordinary artisan. The claims remain prima facie obvious over the cited prior art.

No claims are allowed.

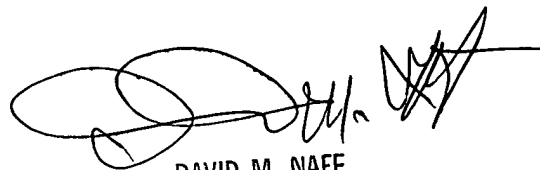
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is (703) 308-4245. The examiner can normally be reached on Mondays to Fridays from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Deborah K. Ware

April 6, 2000

  
DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651